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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/603,144	06/23/2000	Gregory Jones	5053-28000	1593

7590 09/23/2004
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EXAMINER

FRENEL, VANEL

ART UNIT PAPER NUMBER

3626

DATE MAILED: 09/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Km

Office Action Summary

Application No.

09/603,144

Applicant(s)

JONES ET AL.

Examiner

Vanel Frenel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 41-70 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 41-70 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>06/23/04</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Notice to Applicant

1. This communication is in response to the Amendment filed on 06/23/04. Claims 41-70 are pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 41-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al (4,987,538) in view of McKee et al (6,272,482), for the same reason given in the previous Office Action. Further reasons appear hereinbelow.

(A) Claim 41 were apparently amended to include the words "computer", "of the", "at least two of the"; "one or more"; "one or more"; "claims"; "of the formed" and "rules".

However, this change does not affect the scope and the breadth as originally presented /or in the manner in which were interpreted by the Examiner when applying prior art within the previous Office Action. As such, this claim is rejected under the same reason given in the prior Office Action, and incorporated herein.

(B) Claim 42 were apparently amended to include the words "at least one of the".

However, this change does not affect the scope and the breadth as originally presented

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/or in the manner in which were interpreted by the Examiner when applying prior art within the previous Office Action. As such, this claim is rejected under the same reason given in the prior Office Action, and incorporated herein.

(C) Claims 43, 51 and 63 were apparently amended to delete the word "plurality of". However, this change does not affect the scope and the breadth as originally presented /or in the manner in which were interpreted by the Examiner when applying prior art within the previous Office Action. As such, these claims are rejected under the same reason given in the prior Office Action, and incorporated herein.

(D) Claim 44 were apparently amended to include the words "of the formed", "rules", "at least one of the" and "claims". However, these changes do not affect the scope and the breadth as originally presented /or in the manner in which were interpreted by the Examiner when applying prior art within the previous Office Action. As such, this claim is rejected under the same reason given in the prior Office Action, and incorporated herein.

(E) Claim 45 were apparently amended to include the words "of the formed", "at least one of the". However, these changes do not affect the scope and the breadth as originally presented /or in the manner in which were interpreted by the Examiner when applying prior art within the previous Office Action. As such, this claim is rejected under the same reason given in the prior Office Action, and incorporated herein.

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(D) Claim 47 were apparently amended to include the words "implemented on a computer system", "the", "of the", "one or more", "one or more", "claims", "of the", "rules", "the", "of the" and "claims". However, these changes do not affect the scope and the breadth as originally presented /or in the manner in which were interpreted by the Examiner when applying prior art within the previous Office Action. As such, this claim is rejected under the same reason given in the prior Office Action, and incorporated herein.

(F) Claim 48 were apparently amended to include the words "comprising", "of the", "of the" and "rules". However, these changes do not affect the scope and the breadth as originally presented /or in the manner in which were interpreted by the Examiner when applying prior art within the previous Office Action. As such, this claim is rejected under the same reason given in the prior Office Action, and incorporated herein.

(G) Claim 49 and 61 were apparently amended to include the words "of the". However, this change does not affect the scope and the breadth as originally presented /or in the manner in which were interpreted by the Examiner when applying prior art within the previous Office Action. As such, these claims are rejected under the same reason given in the prior Office Action, and incorporated herein.

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(H) Claims 50 and 62 were apparently amended to include the words "of the" and "rules". However, these changes do not affect the scope and the breadth as originally presented /or in the manner in which were interpreted by the Examiner when applying prior art within the previous Office Action. As such, these claims are rejected under the same reason given in the prior Office Action, and incorporated herein.

(I) Claims 52 and 64 were apparently amended to include the words "of the", "rules", "at least one of the" and "the". However, these changes do not affect the scope and the breadth as originally presented /or in the manner in which were interpreted by the Examiner when applying prior art within the previous Office Action. As such, these claims are rejected under the same reason given in the prior Office Action, and incorporated herein.

(J) Claim 53 and 65 were apparently amended to delete the word "of the", "rules" and "comprises". However, these changes do not affect the scope and the breadth as originally presented /or in the manner in which were interpreted by the Examiner when applying prior art within the previous Office Action. As such, these claims are rejected under the same reason given in the prior Office Action, and incorporated herein.

(K) Claim 54 were apparently amended to delete the word "plurality of" and "comprise". However, these changes do not affect the scope and the breadth as originally presented /or in the manner in which were interpreted by the Examiner when

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applying prior art within the previous Office Action. As such, this claim is rejected under the same reason given in the prior Office Action, and incorporated herein.

(L) Claim 55 were apparently amended to delete the word "comprising", "of the", "elements", "of the", "of the", "of the", "elements", "or more" and "rules". However, these changes do not affect the scope and the breadth as originally presented /or in the manner in which were interpreted by the Examiner when applying prior art within the previous Office Action. As such, this claim is rejected under the same reason given in the prior Office Action, and incorporated herein.

(M) Claim 56 were apparently amended to include the words "comprising", "or more of the", "elements", "at least one" and "requirement". However, these changes do not affect the scope and the breadth as originally presented /or in the manner in which were interpreted by the Examiner when applying prior art within the previous Office Action. As such, this claim is rejected under the same reason given in the prior Office Action, and incorporated herein.

(N) Claim 57 were apparently amended to include the words "comprising", "of the", "rules" "of the" and "elements". However, these changes do not affect the scope and the breadth as originally presented /or in the manner in which were interpreted by the Examiner when applying prior art within the previous Office Action. As such, this claim is

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rejected under the same reason given in the prior Office Action, and incorporated herein.

(O) Claim 58 were apparently amended to delete the words "comprising" "of the" and "elements". However, these changes do not affect the scope and the breadth as originally presented /or in the manner in which were interpreted by the Examiner when applying prior art within the previous Office Action. As such, this claim is rejected under the same reason given in the prior Office Action, and incorporated herein.

(P) Claim 59 were apparently amended to include the words "implemented on a computer system", "the", "the", "of the", "one or more", "rules", "one or more", "claims", "of the", "rules", "the", "of the" and "claims". However, these changes do not affect the scope and the breadth as originally presented /or in the manner in which were interpreted by the Examiner when applying prior art within the previous Office Action. As such, this claim is rejected under the same reason given in the prior Office Action, and incorporated herein.

(Q) Claim 60 were apparently amended to include the words "of the", "claims", "of the" and "rules". However, these changes do not affect the scope and the breadth as originally presented /or in the manner in which were interpreted by the Examiner when applying prior art within the previous Office Action. As such, this claim is rejected under the same reason given in the prior Office Action, and incorporated herein.

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(R) Claim 66 were apparently amended to delete the word "plurality of". However, this change does not affect the scope and the breadth as originally presented /or in the manner in which were interpreted by the Examiner when applying prior art within the previous Office Action. As such, this claim is rejected under the same reason given in the prior Office Action, and incorporated herein.

(S) Claim 67 were apparently amended to delete the word "one or more of the", "elements", "of the", "of the", "elements" and "one or more". However, these changes do not affect the scope and the breadth as originally presented /or in the manner in which were interpreted by the Examiner when applying prior art within the previous Office Action. As such, this claim is rejected under the same reason given in the prior Office Action, and incorporated herein.

(T) Claim 68 were apparently amended to include the words "one or more of the", "elements". However, these changes do not affect the scope and the breadth as originally presented /or in the manner in which were interpreted by the Examiner when applying prior art within the previous Office Action. As such, this claim is rejected under the same reason given in the prior Office Action, and incorporated herein.

(U) Claim 69 were apparently amended to include the words "of the", "one of the" and "elements". However, these changes do not affect the scope and the breadth as

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originally presented /or in the manner in which were interpreted by the Examiner when applying prior art within the previous Office Action. As such, this claim is rejected under the same reason given in the prior Office Action, and incorporated herein.

(V) Claim 70 were apparently amended to include the words "of the" and "elements". However, these changes do not affect the scope and the breadth as originally presented /or in the manner in which were interpreted by the Examiner when applying prior art within the previous Office Action. As such, this claim is rejected under the same reason given in the prior Office Action, and incorporated herein.

(W) Claim 46 has not been amended and is therefore rejected for the same reasons given in the previous Office Action, and incorporated herein.

Response to Arguments

4. Applicant's arguments filed 06/17/04 regarding claims 41-70 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 06/17/04.

(A) At pages 8-17 of the 06/17/04 response, Applicant argues the followings:

(1) The claims are not obvious over Johnson et al. in view of McKee et al.

Pursuant to 35 U.S.C 103 (a).

(2) Neither Johnson nor McKee, alone, or in combination, appears to teach or suggest the combination of features of claim 41, including but not limited to, the feature

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of “a translator program configured to read two or more of the business rule data elements from a database, and to combine at least two of the business rule data elements to form one or more business rules”.

(3) “Wherein the business rule data elements are stored in tabular format in the database”.

(4) Johnson does not appear to teach or suggest the features of the claims including, but not limited to, the feature of, “modifying one or more of the business rule data elements in the memory”.

(5) Johnson does not teach the feature of the claim including, but not limited to, the feature of “a rules engine”.

(B) With respect to Applicant's first and second arguments, Examiner respectfully submits that obviousness is not determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977F. 2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1992); *In re Piaseckii*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Using this standard, the Examiner respectfully submits that he has at least satisfied the burden of presenting a prima facie case of obviousness, since he has presented evidence of corresponding claim elements in the prior art and has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention (See the previous Office Action). Note, for example, in the

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instant case, the Examiner respectfully notes that each and every motivation to combine the applied references are accompanied by select portions of the respective reference(s) which specially support that particular motivation and /or an explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness. As such, it is not seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one of ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood*, 28 USPQ2d 1300(Bd. Pat. App. & Inter., 4/22/93). Therefore, the combination of references is proper and the rejection is maintained.

In addition, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. However, although the Examiner agrees that the motivation or suggestion to make modifications must be articulated, it is respectfully contended that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969). Therefore, Applicant's argument is not persuasive.

Further, it is respectfully submitted that Applicant merely provides a piecemeal analysis of the teachings of the McKee and Johnson references, separately, and in a vacuum. As such, it is respectfully submitted that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In addition, with specific reference to Applicant's remarks about the Johnson reference, the Examiner respectfully submits that it is sufficient to demonstrate that the prior art meets the limitations as claimed, whether by a single instance or scenario, or in every possible preferred embodiment, since it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

- (i) obviousness does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references, but what they would suggest.

In addition, Johnson suggests "the source code is a refinement of the logic statements given as examples for the "rules conversion step". The logic is put into proper syntax for the programming language being used, with proper beginning and ending markers for each conditional statement and subroutine. Utility routines are created to re-index and pack the data base as needed, and to make certain user-level modifications to the various parameters" which correspond to Applicant's claimed feature (See Johnson, Col.5, lines 42-50). Therefore, Applicant's argument is non-persuasive.

Further, Johnson suggests "the applicable rules are coded and organized through software programming to provide for the appropriate selection and application of the pertinent rules" which correspond to Applicant claimed feature (See Johnson, Col.7, lines 30-32). Therefore, Applicant's argument is non-persuasive.

(C) With respect to Applicant's third argument, Examiner respectfully submits that Johnson discloses "From Fig.2 the four basic information categories are claim identification, and "other pertinent information". The claim identification identifies the "claimed accepted" status. The provider identification determines whether the provider is an authorized professional. The claim identification also enables the identification of prior provider billings and whether the processed billing is a repeat billing" which correspond to Applicant's claimed feature (See Johnson, Col.3, lines 25-34). Therefore, Applicant's argument is non-persuasive.

(D) With respect to Applicant's fourth argument, Examiner respectfully submits that Johnson discloses "the administrative rules 10 are converted into rules 12 and stored in the memory of the computer to select the appropriate rules and sequentially apply the rules to each specific billing" which correspond to Applicant's claimed feature. Therefore, Applicant's argument is non-persuasive.

(E) In response to Applicant fifth argument Examiner noted He relied upon the prior art of McKee for the teaching of the "rule of engines". In particular, Examiner

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respectfully submits that McKee suggests "a method and system for managing business rules, which facilitates an understanding of the interactions of business rules, and simplifies revision of the rules as required by changes in business procedures and policies" which correspond to Applicant's claimed feature (See McKee, Col.2, lines 50-53). Therefore, Applicant's argument is non-persuasive.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 703-305-4952. The examiner can normally be reached on Monday-Thursday from 6:30am-5:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 703-305-9588. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

V.F
V.F



ALEXANDER KALINOWSKI
PRIMARY EXAMINER

September 8, 2004